

## REMARKS/ARGUMENTS

Responsive to the Office Action mailed August 9, 2007:

### I. NON-PRIOR ART MATTERS

- A. The Office Action rejected claim 13 under 35 U.S.C. 112 second paragraph, as being indefinite for failing to particularly point out an distinctly claim the subject matter which applicant regards as the invention.

The Office Action states:

Regarding claim 13, it does not make sense that the abbreviation can be inserted at any position in the existing text in the limitation "inserting the abbreviation into the pre-existing text at a position selected by the user at any position in the existing text." The insertion of abbreviation can be carried out *only at the position of a word having a corresponding abbreviation*. At other positions of other words that do not have corresponding abbreviations, such insertion appears improper.

With all due respect, the Examiner has no authority arbitrarily to limit Applicant's claims as long as the claim is supported by the original disclosure. Claim 13 as originally filed (which is part of the Specification) did not limit such insertion to only at the position of a word having a corresponding abbreviation.

### II. PRIOR ART MATTERS

- A. The Office Action rejected claims 1-22 under 35 USC 103(a) as being unpatentable over Ichbiah in view of Goldwasser.

The 103 rejection is based on the standard of disclosure of 35 USC 102 as to each reference (MPEP 2141.01):

"Before answering *Graham's* 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987). Subject matter that is prior art under 35 U.S.C. 102 can be used to support a rejection under section 103. *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981) ("it appears to us that the

commentator [of 35 U.S.C.A.] and the [congressional] committee viewed section 103 as including all of the various bars to a patent as set forth in section 102.”).

A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date. For instance, an obviousness rejection over a U.S. patent which was issued more than 1 year before the filing date of the application is said to be a statutory bar just as if it anticipated the claims under 35 U.S.C. 102(b). Analogously, an obviousness rejection based on a publication which would be applied under 102(a) if it anticipated the claims can be overcome by swearing behind the publication date of the reference by filing an affidavit or declaration under 37 CFR 1.131.

“For a prior art reference to anticipate...every element of the claimed invention must be identically shown in a single reference...These elements must be arranged as in the claim under review.”<sup>1</sup> “This standard is very strict. It requires an exact correspondence between the contents of the event and the claim limitations, such that each and every element recited in the claim is present in the anticipatory event.”<sup>2</sup>

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.<sup>3</sup> If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.<sup>4</sup>

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.<sup>5</sup>

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

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<sup>1</sup> *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)

<sup>2</sup> *Moy's Walker on Patents*, 4<sup>th</sup> ed., § 8.11 (citing *In re Spada*, 911 F.2d 705, 708, 15 U.SP.Q.2D(BNA) 1655 (Fed. Cir. 1990))

<sup>3</sup> MPEP Sec. 2142.

<sup>4</sup> *Id.*

<sup>5</sup> *Id.* (emphasis supplied)

1. **The cited prior art does not teach or suggest all the claim limitations.**

Claim 1

As to claim 1, the cited prior art does not disclose:

-actively selecting a word in the pre-existing text to be converted to an abbreviation, converting the selected word to a corresponding abbreviation using the first data structure, and replacing the word with the corresponding abbreviation; and

actively selecting an abbreviation in the pre-existing text to be converted to a word, converting the selected abbreviation to a corresponding word using the second data structure, and replacing the abbreviation with the corresponding word.

The Office Action indicates that Ichbiah discloses:

-actively selecting an abbreviation **in the text** to be converted to a word and converting the abbreviation to a word or phrase....

The Examiner has ignored the claimed limitation of **pre-existing text**. Therefore, the 103 rejection is invalid under the standard of 35 USC 102.

The Examiner supports his incorrect rejection by stating:

In addition, Ichbiah and Goldwasser do not state explicitly that the text for selecting a word or selecting an abbreviation is a pre-existing text. However, it would have been obvious to [one of] an ordinary skill at the time of the invention was made to have recognized that the text used for these selecting [sic] is a pre-existing text so that there are corresponding abbreviations and words ready for them.

This reasoning is faulty:

First, as already stated, and admitted by the Examiner, the limitation is not expressly disclosed in either reference. Therefore, the standard of disclosure that must be met to support a 103 rejection is not satisfied. Second, the Examiner has not determined who is "one of ordinary skill in the art," so that it is impossible to satisfy the *Graham* factors for finding a 103 rejection.

Furthermore, Ichbiah expressly states:

Text entry is input into the system through the entry of word abbreviations, phrase abbreviations, and text entries. Abstract. (emphasis supplied)

Thus, the text to be acted on is not pre-existing, i.e., it does not already exist, available to be operated on by the method, at the time of the first step in the method. The Examiner's reading of the claim would change the principle of operation of the reference, which is not permitted.<sup>6</sup>

Goldwasser expressly states:

A further more specific object of the invention is to provide a method of teaching a Stroke Typing system user the abbreviations, sequences of sequential and/or simultaneous keypresses (strokes), that can be used in place of ordinary letter by letter typing to enter text consisting of linguistic expressions into the computer. Col. 2 lines 50-55. (emphasis supplied)

Again, the text to be acted on is not pre-existing, i.e., it does not already exist, available to be operated on by the method, at the time of the first step in the method. The Examiner's reading of the claim would change the principle of operation of the reference, which is not permitted.<sup>7</sup>

Furthermore, neither Ichbiah nor Goldwasser discloses replacing an abbreviation with the corresponding word and replacing a word with the corresponding abbreviation.

The Examiner is also directed to the Decision on Appeal of Board of Patent Appeals and Interferences dated September 29, 2006, which states in part:

...we note that nothing in claim 1 requires the abbreviation to "replace" a word. The language merely requires a selection of a word in the text to be converted to an abbreviation, then performing the conversion. This much, Goldwasser's system does. Typing in the word into the text is a "selection" of the word wishing to be converted, and, if an abbreviation for that word exists in the data structure, that abbreviation is displayed in the text

<sup>6</sup> MPEP 2143.01(VI) (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

<sup>7</sup> MPEP 2143.01(VI) (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

after the typed letters. The claim says nothing about where the abbreviation is displayed. In fact, independent claim 1 says nothing at all.

Applicant has taken the remarks of the Board into account and has accordingly modified claim 1 to respond to the Board's remark.

Claim 1 is therefore allowable.

Claims 2-14 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

### Claim 13

As to amended claim 13, the Office Action has not shown where Ichbiah or Goldwasser disclose:

selecting an abbreviation from the first data structure and inserting the abbreviation into the pre-existing text at a position selected by the user at any position in the existing text.

Furthermore, the references do not disclose that the text is a pre-existing text.

The Office Action states:

Ichbiah does not disclose that the text is a pre-existing text. However, it would have been obvious to [one of] an ordinary skill at the time of the invention was made to have recognized that the text used for these selecting [sic] is a pre-existing text so that there are corresponding abbreviations and words ready for them to be replaced.

This reasoning is faulty for the reasons discussed above in regard to claim 1.

The Examiner is also directed to the Decision on Appeal of Board of Patent Appeals and Interferences dated September 29, 2006, which states in part:

We note that the claim does not say that a user may select any of a plurality of positions, or any position within the text. It says merely that the abbreviation is inserted into the text at a position selected

by the user. The user, typing in a given word, is making the position selection at that time by typing the word at a selected position. Therefore, in our view, the broad language of claim 13 is met.

Applicant respectfully differs with the Board's remark.

In patent claim construction, the indefinite article "a" is construed to mean "one or more.":

A general rule is that an indefinite article "a" or "an" in a patent claim means "one or more," not "only one," unless the claim is "specific as to the number of elements" or the context of the claim "suggests ambiguity" in the meaning of the indefinite article.<sup>8</sup>

Therefore, the language "at a position" should be interpreted as "at one or more positions." Goldwasser thus does not satisfy the language of claim 13, because Goldwasser only permits insertion of an abbreviation at the point in the text entry where the user is typing.

Claim 13 is therefore allowable.

Claim 14 contains additional elements or limitations beyond allowable claim 1 and is also allowable.

Claim 15 is allowable for the reasons given above in regard to claim 1.

Claim 17 is allowable for the reasons given above in regard to claim 1.

Claims 18-22 contain additional elements or limitations beyond allowable claim 17 and are also allowable.

B. The Examiner has not applied the test of *Graham v. John Deere Co.*<sup>9</sup> The MPEP requires the Examiner to do so.<sup>10</sup> However, the Examiner has made no finding of the level of ordinary skill in the art.<sup>11</sup>

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<sup>8</sup> *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 55 USPQ2d 1835 (Fed. Cir. 2000).

<sup>9</sup> 383 U.S. 1 (1966)

<sup>10</sup> MPEP § 2141

<sup>11</sup> MPEP § 2141.03


The Federal Circuit routinely vacates conclusions of obviousness when the factfinder failed to make *Graham* factor findings.<sup>12</sup> This is especially so when the factfinder makes conclusory statements that "'do not fulfill the agency's obligation' to explain all material facts relating to a motivation to combine."<sup>13</sup>

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 02-3732.

Respectfully submitted,

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<sup>12</sup> *Dystar*, 464 F.3d 1366 and cases cited therein.

<sup>13</sup> *Id.*